REMARKS

Claims 1-18 are originally pending. No claims have been amended, canceled, or added.

As a preliminary matter, a Response filed on 22 February 2005 provides detailed reasons why claims 1-6 and 13-18 are not anticipated by U.S. Patent No. 5,867,164 to Bornstein et al. ("Bornstein"). These reasons indicating why the pending claims are patentably distinguished from Bornstein are not reiterated verbatim herein, but are incorporated by reference. The Office is urged to reconsider those previously presented arguments in view of the following remarks/arguments, in view of which, the Office is respectfully requested to withdraw the outstanding rejections to the pending claims.

35 USC §102 Rejections

Claims 1-6 and 13-18 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,867,164 to Bornstein et al. ("Bornstein"). These rejections are traversed.

It is a fundamental principal of patent law that to anticipate a claim, a single reference must teach each and every element of the claim as set forth in the claim. (MPEP §2131). Bornstein does not explicitly or inherently describe each and every element of pending claims 1-6 and 13-18 for the following reasons.

Claim 1 recites "constructing a sentence-based summary of a document's writings, and "inserting the sentence-based summary at a beginning of the document". In addressing claim 1, the Action at section 6,

asserts that "the Bornstein reference to the top sentence, which includes information regarding the document, being displayed in a display element is indication of a sentence base summary of document as illustrated in applicants claim language." Applicant respectfully disagrees with this assertion.

Bornstein's presentation of information in a display element does not explicitly or inherently describe "inserting" anything into the document from which the top sentence was derived. Bornstein merely describes independently generating a top sentence from a document, displaying information representing document content in a user interface (i.e., the display element), and displaying the top sentence in the display element. When Bornstein describes that information representing document content is presented in a user interface, and further describes displaying a top sentence derived from analysis of the document in that same user interface, this does not mean, without any additional description—description that is clearly missing from Bornstein—that the actual document was edited or modified to insert the top sentence into that document. This is especially the case since Bornstein is completely silent on any such "inserting" into the document.

Just as a video memory representation of a document is not "the document", as Applicant claims, presenting information in a user interface is just not that same as "inserting the sentence-based summary at a beginning of the document", as claim 1 recites. Instead, displaying a top sentence in a user interface for viewing by a user, regardless of whether the user interface also presents a user intelligible representation of the

document from which the top sentence was derived, is just that: displaying a top sentence in a user interface, and nothing more. Thus, a system of Bornstein may never "constructing a sentence-based summary of a document's writings, and "inserting the sentence-based summary at a beginning of the document", as claim 1 recites.

Accordingly, the 35 USC §102(e) rejection of claim 1 as anticipated by Bornstein is improper and should be withdrawn.

Claims 2-6 depend from claim 1 and are allowable over Bornstein solely by virtue of this dependency.

Accordingly, the 35 USC §102(e) rejections of claims 2-6 are improper and should be withdrawn.

Claim 13 recites "constructing a textual content-based summary of a document's writings", and "inserting the textual content-based summary at a beginning of the document and on a common page with starting content of the document".

For the reasons already discussed above with respect to claim 1, Bornstein does not anticipate these features of claim 13.

Accordingly, the 35 USC §102(e) rejection of claim 13 is improper and should be withdrawn

Claims 14-18 depend from claim 13 and are allowable over Bornstein solely by virtue of this dependency.

Accordingly, the 35 USC §102(e) rejection of claims 14-18 is improper and should be withdrawn

35 USC §103 Rejections

Claims 7-12 stand rejected under 35 USC §103(a) as being unpatentable over Bornstein in view of Stark et al., "The Working Word", PC Magazine, p. 487, Oct. 16, 1990 (hereinafter referred to as "Stark"). These rejections are traversed.

Claim 7 recites "evaluating words in the document to identify ordered sets of words that appear repeatedly in a same order", "ranking individual sentences in the document by treating the ordered sets of words as if they were single words", and "generating the summary based at least in part on the sentence rankings." Bornstein in view of Stark does not teach or suggest these claimed features for the following reasons.

In addressing claim 7, the Action points to Bornstein's teaching of "determining the significance of particular words and/or sentences, usually by focusing on position in the document, semantic relationships, and term frequencies" to conclude that Bornstein teaches "identify ordered sets of words that appear repeatedly in a same order", as claim 7 recites. Applicant respectfully disagrees.

Bornstein's teaching that word significance is a function of document positions, semantic relationships, and term frequencies does not teach or suggest "identify ordered sets of words that appear repeatedly in a same order", as claim 7 recites. This is especially the case since Bornstein, with the exception of teaching that a "window instantaneously updates to *display a summary with more or less detail and in the same order as the original document*" [emphasis added], is completely silent with respect to "the same order" of anything else. As such, Bornstein's broad teaching that

word significance is a function of document positions, semantic relationships, and term frequencies does not warrant modification by the Action to arrive at the claimed "evaluating words in the document to identify ordered sets of words that appear repeatedly in a same order", as claim 7 recites.

The Action does not rely on Stark for "evaluating words in the document to identify ordered sets of words that appear repeatedly in a same order", as claim 7 recites. Moreover, Stark is completely silent with respect to these claimed features.

In view of the above, a prima facie case of obviousness of claim 7 over Bornstein in view of Stark has not been presented. For this reason alone, the 35 USC §103(a) rejection of claim 7 over Bornstein in view of Stark is improper and should be withdrawn.

Additionally, the Action's modification to Bornstein is not supported by way of prior art citation, common knowledge in the art, or cited legal precedent. Thus, this unsupported modification to Bornstein is seemingly either a result of personal knowledge or being made with impermissible hindsight reconstruction of the features of claim 7. "When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." 37 CFR §1.104(d)(2). In view of this, if this rejection is maintained on a similar basis in a subsequent Action, the Examiner is respectfully requested to

1   supply such an affidavit to support this otherwise unsupported modification

2   to Bornstein.

3   Moreover, in addressing claim 7, the Action admits that Bornstein

4   does not teach or suggest "ranking individual sentences in the document by

5   treating the ordered sets of words as if they were single words", as claim 7

6   recites. To provide this conceded missing feature, the Action points to

7   Stark's teaching that "the program lets me count the occurrence of odds,

8   characters, or phrases". In reliance on this teaching of counting odds,

9   characters, or phrases, the Action concludes that it would have been

10 obvious for a person of ordinary skill in the art at the time of invention to

11 have combined Stark with Bornstein because "the program lets me count

12 the occurrence of odds, characters, or phrases" would give those skilled in

13 the art tools to search documents for single words and phrases. Applicant

14 respectfully disagrees.

15   It is respectfully submitted that counting the occurrence of odds,

16 characters, or phrases, even if it provided one skilled in the art a tool to

17 search documents for single words and phrases, does not teach or suggest

18 "ranking individual sentences in the document by treating the ordered sets

19 of words as if they were single words". Instead, counting the occurrence

20 of odds, characters, or phrases, as taught by Stark, merely results in counts,

21 or indication(s) of the number of odds, characters, or phrases in a

22 document. Combining Bornstein's sentence ranking with Starks odd,

23 character, or phrase counts likely results in sentence rankings based on odd,

24 character, or phrase counts. Clearly, nowhere does such a result reached by

25 this combination of references teach or suggest "ranking individual

sentences in the document by *treating the ordered sets of words as if they were single words*", as claim 7 recites [emphasis added].

For this additional reason, the 35 USC §103(a) rejection of claim 7 over Bornstein in view of Stark is improper and should be withdrawn.

Claims 8-12 depend from claim 7 and are allowable over Bornstein in view of Stark solely by virtue of this dependency.

Accordingly, the 35 USC §103(a) rejection of claims 8-12 is improper and should be withdrawn.

Conclusion

Pending claims 1-18 are in condition for allowance, and action to that end is respectfully requested. Should any issue remain that prevents allowance of the application, the Office is encouraged to contact the undersigned prior or issuance of an Advisory action.

Respectfully submitted,

Dated: __7/12/2005__   By: _____
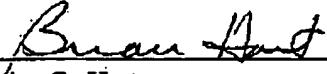
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